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10/519,407	01/05/2005	Hiroyuki Naitou	264178US0PCT	9968

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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HAILEY, PATRICIA L

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1 RECORD OF ORAL HEARING

2  
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES

8  
9  
10 Ex parte HIROYUKI NAITOU  
11 and TAKASHI KARASUDA

12  
13  
14 Appeal 2009-004954  
15 Application 10/519,407  
16 Technology Center 1700

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18  
19 Oral Hearing Held: July 8, 2009  
20

21  
22  
23 Before CATHERINE Q. TIMM, LINDA M. GAUDETTE, and  
24 KAREN M. HASTINGS, Administrative Patent Judges

25  
26  
27 ON BEHALF OF THE APPELLANT:  
28 HARRIS A. PITLICK, ESQUIRE  
29 Oblon, Spivak, McClelland,  
30 Maier & Neustadt, P.C.  
31 1940 Duke Street  
32 Alexandria, Virginia 22314  
33 (703) 413-3000

34  
35 ALSO PRESENT:  
36 Cheryl Moore  
37  
38  
39

1       The above-entitled matter came on for hearing on Wednesday,  
2       July 8, 2009, commencing at 9:05 a.m., at the U.S. Patent and Trademark  
3       Office, 600 Dulany Street, Alexandria, Virginia, before Paula L. Lowery,  
4       Notary Public.

5       THE CLERK: Good morning. Calendar Number 16, Appeal No.  
6       2009-4954, Mr. Pitlick.

7       JUDGE TIMM: Good morning, Mr. Pitlick.

8       MR. PITLICK: Good morning.

9       JUDGE TIMM: As you know, you have 20 minutes. If you would  
10      state your name for the record for our court reporter.

11      MR. PITLICK: My name is Harris Pitlick. I have a business card for  
12      the reporter.

13      JUDGE TIMM: You may begin when you're ready.

14      MR. PITLICK: Before I start, just a housekeeping issue. The Board,  
15      in an order dated March 12, 2008, order returning of undocketed appeal to  
16      Examiner because one of the references was a Japanese reference, and there  
17      was an English-machine translation in the record.

18      We've never received a traditional translation. It doesn't matter to us  
19      because its reference, actually, which I'll get to shortly, is one of ours; and  
20      it's a reference the Examiner has rejected over.

21      Just out of curiosity, more than anything else, I'd like to know whether  
22      or not the Board received a copy of this reference.

23      JUDGE GAUDETTE: Yes, we have a copy –

24      MR. PITLICK: Okay.

25      JUDGE GAUDETTE: -- of the translation.

26

1           MR. PITLICK: I guess I'll have to go check PAIR again, but I don't  
2 believe we've received a copy.

3           At any rate there's one issue here, and that's whether the present  
4 claims are unpatentable under 35 USC Sec. 103(a) over this Naito that I'll  
5 reference.

6           The present invention is an improvement over Naito, et al. The  
7 invention involves mixing three different solutions or slurries of defined  
8 composition.

9           What applicants have discovered is if you mix what we call  
10 composition B with either A or C, or the combination of A and C over a  
11 particular time range -- when I say mixing, we've indicated in the Appeal  
12 Brief, and it's not controversial, that we're talking about the time in which  
13 this composition B is added to the A, the C, or the combination of A and C.

14           This is a result-effective variable, and the catalyst that is made by this  
15 particular process results in greater selectivity and conversion when the  
16 catalyst is used to form methacrylic acid from the catalytic oxidation  
17 methacryl.

18           The reference Naito, et al. also has the same three compositions, but  
19 what the invention of the reference is that you have to mix A and B together  
20 and add that to C.

21           Now, there are a couple of embodiments. You can add A into B, or B  
22 into A, but the bottom line is you have to have A and B together, and you  
23 mix it with C.

24           So as we've argued in the Appeal Brief and Reply Brief, there's no  
25 prima facie case of obviousness here. One reason, it was not known that this  
26 additional mixing time was going to affect the variable.

1           So, one, it hasn't been shown to be a result-effective variable. Plus,  
2 we've also shown superior results, which the Examiner really has not  
3 disputed at all.

4           We've also shown, for example, that Example 8 of Naito, et al. is the  
5 same as our comparative Example 4.

6           The reason we put that in there is because Naito does not disclose  
7 what the mixing or addition time was in that example. We've shown that it  
8 was actually 30 minutes. It was outside the range of our claims.

9           But at least some of the examples in the prior examples which you  
10 talked about, everything was identical except the mixing or adding time of  
11 B, and we've shown greater result.

12           Also, which we talked about in the Brief, we've actually shown that if  
13 you use the order of addition that Naito talks about as something that you  
14 don't do -- in other words, for example, A plus C and then B, or something  
15 other than A plus B and then C -- if you do that but yet add B within the  
16 terms of our claim, you'll actually get a much superior result.

17           So that's our case in a nutshell. I'll be happy to try and answer any  
18 questions that you may have.

19           JUDGE TIMM: Do you have any questions?

20           JUDGE GAUDETTE: No.

21           JUDGE HASTINGS: No.

22           JUDGE TIMM: No questions.

23           MR. PITLICK: Thank you.

24           JUDGE TIMM: We're off the record.

25           Whereupon, the proceedings at 9:10 a.m. were concluded.